

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant : Atsushi MIYAWAKI et al.

Confirmation No.: 5047

Serial No : 10/581,551  
(National Stage of PCT/JP2004/018437)

Group Art Unit: 1645

I.A. Filed : December 3, 2004

Examiner: not yet assigned

For : FLUORESCENT PROTEIN

**INFORMATION DISCLOSURE STATEMENT**

Commissioner of Patents  
U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Amendment  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Pursuant to 37 C.F.R. § 1.56 and 37 C.F.R. §§ 1.97-1.98, Applicants hereby direct the Examiner's attention to the following documents cited in the International Search Report for International Application PCT/JP2004/018437 of which the above-referenced application is a national phase:

- (1) CAMPBELL R. E., et al. "A monomeric red fluorescent protein",  
Proceedings of the National Academy of Sciences of the United States  
of America, vol. 99 (2002), no. 12, pp. 7877-7882;
- (2) KARASAWA S., et al. "A Green-emitting Fluorescent Protein from  
*Galaxeida* Coral and Its Monomeric Version for Use in Fluorescent  
Labeling" The Journal of Biological Chemistry, vol. 278 (2003), no. 36,  
pp. 34167-34171;
- (3) WO 03/054191 A1, July 3, 2003; Applicants note that this document is  
also cited and discussed, beginning at page 2, lines 14, 25 of the  
present specification;

- (4) EP 1 464 701 A1, October 6, 2004; Applicants note that this document is a family member of document (3); and
- (5) WO 02/070703 A2, September 12, 2002.

Furthermore, Applicants direct the Examiner's attention to the following co-pending and commonly assigned U.S. patent applications:

- (6) U.S. Patent Application No. 10/492,081 (MIYAWAKI et al.), filed October 10, 2002 and entitled "Fluorescent Protein"; Applicants note that this document is the national stage of PCT/JP2002/10529, which has published as WO 03/033693 A1 on April 24, 2003.
- (7) U.S. Patent Application No. 10/498,505 (MIYAWAKI et al.), filed December 20, 2002 and entitled "Fluorescent Protein"; Applicants note that this document is the national stage of PCT/JP2002/13363, which has published as WO 03/054191 A1 on July 3, 2003 (document (3)).
- (8) U.S. Patent Application No. 10/525,365 (MIYAWAKI et al.), filed August 22, 2003 and entitled "Fluorescent protein and Chromoprotein"; Applicants note that this document is the national stage of PCT/JP2003/10628, which has published as WO 2004/018671 A1 on March 4, 2004.
- (9) U.S. Patent Application No. 10/561,041 (MIYAWAKI et al.), filed June 16, 2004 and entitled "Fluorescent Protein and Pigment Protein"; Applicants note that this document is the national stage of PCT/JP2004/008786, which has published as WO 2004/111235 A1 on December 23, 2004.

- (10) U.S. Patent Application No. 10/581,040 (MIYAWAKI et al.), filed June 16, 2004 and entitled "Fluorescent Proteins from Favia Favus Coral"; Applicants note that this document is the national stage of PCT/JP2004/008790, which has published as WO 2004/111236 A1 on December 23, 2004.
- (11) U.S. Patent Application No. 11/390,215 (MIYAWAKI et al.), filed March 28, 2006 and entitled "Method for Analysis of Protein Interaction using Fluorescent Protein."

Applicants further direct the Office's attention to the following document which is cited and discussed in the present application:

- (12) TSIEN, R.Y., "The Green Fluorescent Protein," Annual Review of Biochemistry, vol. 67, 1998, pp. 509-44; Applicants note that this document is cited and discussed in the specification, beginning at page 1, line 24.


Copies of the above-listed documents (with the exception of U.S. patents and U.S. patent applications) and the International Search Report (in English) for International Application PCT/JP2004/01843 are enclosed together with a completed copy of the PTO-1449 Form listing these documents. Accordingly, the Examiner is requested to consider these documents and to indicate such consideration by returning a signed and initialed copy of the PTO-1449 Form with the next official communication.

Further to 37 C.F.R. §1.98 (a)(2)(ii) and to the U.S. Patent and Trademark Office's decision to waive the requirement under 37 C.F.R. §1.98 (a)(2)(iii) if a U.S. patent application was filed after June 30, 2003, copies of the U.S. patents and patent applications are not enclosed herewith. However, if a copy is needed, the Examiner is respectfully requested to contact the undersigned.

Applicants note that an Office Action on the merits has not yet issued in the instant application, and thus, no fee is necessary to ensure consideration of this statement. However, if an Office Action has issued and is crossing in the mail with this statement, the Patent and Trademark Office is hereby authorized to charge Deposit Account No. 19-0089 any fee necessary to ensure consideration of the submitted materials.

If there should be any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,  
Atsushi MIYAWAKI et al.

  
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FORM PTO-1449		U.S. Department of Commerce Patent and Trademark Office		Atty. Docket No. P30056		Application No. 10/581,551	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Use several sheets if necessary)				Applicant Atsushi MIYAWAKI et al.			
				Filing Date December 3, 2004		Group 1645	

U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE

FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES      NO
	03	/ 0 5 4 1 9 1	07/03/03	W.I.P.O			
		1 4 6 4 7 0 1	10/06/04	E.P.O			
	02	/ 0 7 0 7 0 3	09/12/02	W.I.P.O			
	03	/ 0 3 3 6 9 3	04/24/03	W.I.P.O			
	2004	/ 0 1 8 6 7 1	03/04/04	W.I.P.O			
	2004	/ 0 0 0 2 3 5	12/23/04	W.I.P.O			
	2004	/ 0 0 0 2 3 6	12/23/04	W.I.P.O			

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)		
	1	CAMPBELL R. E., et al. "A monomeric red fluorescent protein", Proceedings of the National Academy of Sciences of the United States of America, vol. 99 (2002), no. 12, pp. 7877-7882.
	2	KARASAWA S., et al. "A Green-emitting Fluorescent Protein from <i>Galaxeida</i> Coral and Its Monomeric Version for Use in Fluorescent Labeling" The Journal of Biological Chemistry, vol. 278 (2003), no. 36, pp. 34167-34171.
	3	U.S. Patent Application No. 10/492,081 (MIYAWAKI et al.), filed October 10, 2002 and entitled "Fluorescent Protein".
	4	U.S. Patent Application No. 11/390,215 (MIYAWAKI et al.), filed March 28, 2006 and entitled "Method for Analysis of Protein Interaction using Fluorescent Protein."
	5	U.S. Patent Application No. 10/498,505 (MIYAWAKI et al.), filed December 20, 2002 and entitled "Fluorescent Protein".
	6	U.S. Patent Application No. 10/525,365 (MIYAWAKI et al.), filed August 22, 2003 and entitled "Fluorescent protein and Chromoprotein".
	7	U.S. Patent Application No. 10/561,041 (MIYAWAKI et al.), filed June 16, 2004 and entitled "Fluorescent Protein and Pigment Protein".
	8	U.S. Patent Application No. 10/581,040 (MIYAWAKI et al.), filed June 16, 2004 and entitled "Fluorescent Proteins from <i>Favia Favus</i> Coral".
	9	TSIEN, R.Y., "The Green Fluorescent Protein," Annual Review of Biochemistry, vol. 67, 1998, pp. 509-44.

EXAMINER	DATE CONSIDERED
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\*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.